

Rather, one asserting that a reference inherently discloses certain subject matter must prove that the features are:

necessarily present [in the prior art reference] and that it would be so recognized by persons of ordinary skill. (Id.)

Here, the Examiner has not satisfied the requisite legal standard. Kamyia discloses numerous different articles having various shapes. (See, e.g., Kamyia at Figs. 1-29.) None of these articles could be interpreted as being generally spherical, let alone a generally spherical embolic particle. Accordingly, upon reading Kamyia, a person of ordinary skill in the art would not recognize that any of Kamyia's articles are necessarily generally spherical, and certainly would not recognize that any of Kamyia's articles are necessarily a generally spherical embolic particle.

In view of the foregoing, Applicants request reconsideration and withdrawal of the rejection of claims 1-10, 17, 25-27 and 29-39 under 35 U.S.C. §102(b) as being anticipated by Kamyia.

The Examiner also rejected claims 1-10, 17, 25-27 and 29-39 under 35 U.S.C. §102(b) as being anticipated by A. Laurent, "Materials and Biomaterials for Interventional Radiology", *Biomed. & Pharmacother.* 1998: 52: 76-88 ("Laurent").

In Applicants' Amendment mailed March 8, 2006, Applicants set forth a legally sound argument regarding why, under the appropriate legal standards, Laurent does not disclose the subject matter covered by claims 1-10, 17, 25-27 and 29-39.<sup>1</sup> Applicants' argument cited appropriate caselaw and analyzed Laurent by referring to the different sections of Laurent and the subject matter disclosed in these different sections. It is Applicants understanding that, under these circumstances, the Examiner has a duty to answer the substance of this argument. (See, e.g., M.P.E.P §707.07(f).) However, rather than satisfying this duty, the Examiner maintained the rejection and simply stated:

See the whole Laurent article.

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<sup>1</sup> This argument is incorporated by reference into this Reply.

Applicant : Paul DiCarlo et al.  
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The amendments and remarks filed by applicants in their last response have been fully considered. The arguments have not been found persuasive. The examiner believes the rejections are still proper and are maintained. (Office Action mailed June 1, 2006 at 2.)

In view of Applicants' belief that the Examiner has not properly considered Applicants' argument regarding Laurent, Applicants again request reconsideration and withdrawal of the rejection of claims 1-10, 17, 25-27 and 29-39 under 35 U.S.C. §102(b) as being anticipated by Laurent.<sup>2</sup>

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,



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Date: July 10, 2006

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<sup>2</sup> Applicants believe that, should the Examiner wish to maintain this rejection, the Examiner must explain with appropriate specificity why, in view of Applicants' argument regarding their position that Laurent does not disclose the subject matter covered by claims 1-10, 17, 25-27 and 29-39, the Examiner is maintaining the rejection.